



12-1504

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

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# TRANSMITTAL FORM

Application Number	09/640,526
Filing Date	August 17, 2000
First Named Inventor	Nicolson, et al
Art Unit	1714
Examiner Name	Edward Cain
Attorney Docket Number	003707.00009

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

## ENCLOSURES (check all that apply)

- ☒ Fee Transmittal Form
  - ☐ Fee Attached
- ☐ Amendment / Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☒ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Reply to Missing Parts/ Incomplete Application
  - ☐ Reply to Missing Parts under 37 CFR1.52 or 1.53

- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) \_\_\_\_\_
  - ☐ Landscape Table on CD

- ☐ After Allowance Communication to TC
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) (please identify below):
  - IDS Form PTO/SB/08A&B
  - Copies of Cited References
  - Certificate of Express Mail
  - Return Receipt Postcard

### Remarks

The Commissioner is hereby authorized to charge any deficiency in fees or credit any overpayment of fees to our deposit account # 19-0733.

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Banner & Witcoff, LTD.

Signature

Printed Name

Shawn Gorman

Date

December 14, 2004

Reg. No.

56,197

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

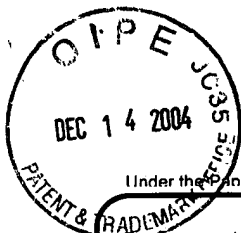
Signature

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PTO/SB/17 (12-04)

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Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

# FEE TRANSMITTAL

## For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 180.00

**Complete if Known**

Application Number	09/640,526
Filing Date	August 17, 2000
First Named Inventor	Nicolson, et al
Examiner Name	Edward Cain
Art Unit	1714
Attorney Docket No.	003707.00009

**METHOD OF PAYMENT (check all that apply)**☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_☒ Deposit Account Deposit Account Number: 19-0733 Deposit Account Name: Banner & Witcoff

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**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Small Entity Fee (\$)	Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims	Fee (\$)	Fee Paid (\$)
- 20 or HP =	x	=				
HP = highest number of total claims paid for, if greater than 20						
Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)			
- 3 or HP =	x	=				
HP = highest number of independent claims paid for, if greater than 3						

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	(round up to a whole number) x	=	

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other: IDS 180.00

**SUBMITTED BY**

Signature	Shawn Gorman	Registration No. (Attorney/Agent)	56,197	Telephone	312-463-5000
Name (Print/Type)	Shawn Gorman			Date	12/14/04

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(Attorney Docket No. 003707.00009)

In re U.S. Patent Application of : )  
Nicolson, et al. ) Examiner: Edward Cain  
Application No. 09/640,526 ) Art Unit: 1714  
Filed: August 17, 2000 ) Confirmation No. 6172  
For: Extended Wear Ophthalmic Lens )

**INFORMATION DISCLOSURE STATEMENT**

Mail Stop Amendment  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Pursuant to 37 C.F.R. Section 1.97-1.98, Applicants wish to make the following references listed on the enclosed Form PTO/SB/08A&B of record in the above-identified application. This Information Disclosure Statement is in compliance with the continuing duty of candor as set forth in 37 C.F.R. Section 1.56.

As this Information Disclosure Statement is being submitted after the issuance of an office action on the merits, the Commissioner is hereby authorized to charge any fee due or credit any overpayment of fee to Deposit Account No. 19-0733.


12/16/2004 RADDFO1 00000036 190733 09640526  
01 FC:1806 180.00 DA

Respectfully submitted,

**BANNER & WITCOFF, LTD.**

Dated: December 14, 2004

By:

  
Shawn Gorman  
Reg. No. 56,197

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PTO/SB/08a (05-03)



PTO/SB/08b(05-03)

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Substitute for form 1449A/PTO

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(use as many sheets as necessary)

Sheet 2 of 2

**Complete if Known**

Application Number	09/640,526
Filing Date	August 17, 2000
First Named Inventor	Nicolson, et al
Group Art Unit	1714
Examiner Name	Edward Cain
Attorney Docket Number	003707.00009

**OTHER PRIOR ART -- NON PATENT LITERATURE DOCUMENTS**

Examiner Initials *	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
		HUNG, WILLIAM, Preparation and Testing Silicone Containing Hydrogel Lenses as Described in US Patent No. 52160000, submitted to EP patent office regarding EP Patent No. 0819258, April 1, 2004.	
		BREUER & MULLER, Grounds of Appeal, in EP Patent application 96 908 116.5-2217, dated April 1, 2004.	
		FISHER, ADRIAN JOHN, Submissions of Opponent II in response to the Proprietors' Appeal, dated August 24, 2004.	
		WINTERTON, LYNN C., et al., Coulometric Method for Measuring Oxygen Flux and Dk of Contact Lenses and Lens Materials, ICLC, vol. 14, No. 11, November 1987, pp. 441-450.	
		Declaration of William J. Benjamin, Professor of Optometry and Physiological Optic University of Alabama at Birmingham, August 24, 2004.	
		Package Insert, Focus Night & Day Soft Contact Lenses for Extended Wear, print date: September 2001.	
		Order of J. Merkel in Federal Court of Australia, Victoria District Registry, Novartis AG v. Bausch & Lomb (Australia) Pty, Ltd [2004] FCA 835, dated August 24, 2004.	
		Criticism of the Experimental Report provided by Dr. William M. Hung., submitted to EP patent office regarding EP Patent No. 0819258, August 24, 2004.	
		HEIDELBERG, ALFRED HUTHIG VERLAG; Praktikum Der Makromolekularen Organischen Chemie, 1996. (Translation of relevant section included)	
		EP Patent application No. 90810308.8; Answer to EPO concerning Office Action, dated March 30, 1994. (Translation of relevant section included)	

Examiner  
SignatureDate  
Considered

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

1 Applicant's unique citation designation number (optional). 2 Applicant is to place a check mark here if English language Translation is attached. This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 120 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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